

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

NOV 17, 97

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Perrigo Company of Tennessee

Serial Nos. 74/517,819, 74/551,764

Harold W. Reick of Price, Heneveld, Cooper, DeWitt & Litton
for applicant.

Nancy L. Hankin, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before Hohein, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Perrigo Company of Tennessee has filed two trademark
applications to register the mark HYDROXY RENEWAL for "skin
cream"¹ and for "skin and bath preparations, namely, creams,

¹ Serial No. 74/517,819, in International Class 3, filed April 28, 1994,
based on an allegation of a bona fide intention to use the mark in
commerce in connection with the identified goods.

lotions, oils, emollients, facial masques, moisturizers, gels, ointments, bath oils and soaps.”²

In both cases, the Trademark Examining Attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant’s mark is merely descriptive of its goods.

Applicant has appealed. In the interest of judicial economy, as the issues in these two appeals are the same and the facts are similar, we consider the appeals together and issue a single opinion. Both applicant and the Examining Attorney have filed briefs, but oral hearings were not requested. We reverse the refusal to register in each case.

The Examining Attorney contends that HYDROXY RENEWAL is merely descriptive of “the primary purpose of the goods [which is] to accelerate cell renewal by using a product containing alpha hydroxy acids, an exfoliant”; that applicant’s skin creams, in fact, contain alpha hydroxy acids; that the evidence of record supports the conclusion that the term HYDROXY is recognized as a shortened reference to alpha hydroxy acids; that the purpose of alpha hydroxy acids is to facilitate skin renewal; that there is a category of skin care products called renewal creams; and, thus, that “HYDROXY and RENEWAL are descriptive when viewed

² Serial No. 74/551,764, in International Class 3, filed July 21, 1994, based on an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods. The application includes a disclaimer of HYDROXY apart from the mark as a whole.

separately and retain the same descriptive meaning when viewed together". In support of the Examining Attorney's position, both records include excerpts of articles from the LEXIS/NEXIS database.

Applicant contends, on the other hand, that the Examining Attorney has improperly dissected the mark and that the mark as a whole does not describe any particular property or feature of applicant's goods; that the evidence of record does not show any descriptive use of the phrase HYDROXY RENEWAL; that consumers would not recognize the term HYDROXY as descriptive of a "constituent of a chemical ingredient which may be contained by a skin cream"³; and that "[w]hen combined with the word 'Renewal,' the composite mark, at most, is only suggestive of a possible quality of treatment or results obtained using the product and only vaguely suggestive of a chemical element which it may contain, and that only to a chemist and not an ordinary consumer of the product".

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of a product or service. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re*

³ We find applicant's statement in this regard unpersuasive in view of its disclaimer, in application Serial No. 74/551,764, of the term HYDROXY.

Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

We take notice of the definition of HYDROXY as "adj. A combining form used in the names of chemical compounds in which the hydroxyl group is present"⁴ and of "hydroxyl" as "n. The univalent radical or group OH, typical of bases, certain acids, phenols, alcohols, carboxylic and sulfonic acids, and amphoteric compounds."⁵ The LEXIS/NEXIS evidence submitted by the Examining Attorney includes numerous references to "alpha hydroxy acid," also referred to as AHA, as an ingredient in skin creams and other cosmetics;⁶

⁴ *The Random House Dictionary of the English Language*, unabridged (2d ed. 1987).

⁵ Webster's II New Riverside University Dictionary, 1984.

⁶ *For example*: "Alpha hydroxy acids are considered the miracle workers of the 1990's. Derived mostly from fruit, they are highly touted

numerous references to a variety of chemical compounds containing the term HYDROXY and pertaining to uses unrelated to cosmetics; and single references to Ceramide Hydroxy Acid, beta hydroxy acid, and olive hydroxy acid as ingredients in cosmetics. The evidence also contains several references to "renewal cream" as a particular type of cosmetic skin cream.⁷

In each of the present cases, we find that the Examining Attorney has not established that, when applied to applicant's goods, the term HYDROXY RENEWAL immediately describes, without conjecture or speculation, a significant feature or function of such goods. We believe that some cogitation or mental processing would be required for prospective customers of applicant's goods to readily perceive the merely descriptive significance of HYDROXY

because, like Retin-A, they speed up the . . . exfoliation process and enhance the skin's surface. They are available in varying strengths from dermatologists and can be found in over-the-counter cosmetics including night creams, hand lotion and lip gloss." *The Dayton Daily News*, February 13, 1996. "Alpha Nutrium is the main ingredient in Pond's new Age Defying Lotion and Self-foaming Facial Cleanser. Alpha Nutrium delivers three alpha hydroxy acids, plus a unique mix of vitamins A and E. *The Plain Dealer*, August 25, 1994.

⁷ For example: "Porcelana Renewal Cream is Dep's entry into the burgeoning category of alpha hydroxy acid products, which remove dead skin cell leaving skin smoother." *Brandweek*, April 18, 1994. "Oil of Olay has created Visible Recovery Series, three products that nourish, revitalize and renew the skin's appearance. Renewal Cream is a moisturizer with a hydroxy compound (salicylic acid) that . . . exfoliates the skin's top layers . . ." *The Atlanta Journal and Constitution*, April 3, 1994. "In skin care Naturistics continues to focus and expand its business. Last year's introduction of Alpha Natural skin renewal cream and lotion reformulated with a multifruit AHA complex has been an important entry . . ." *Chain Drug Review*, July 3, 1995.

RENEWAL as it pertains to applicant's skin care products. The Examining Attorney has established that RENEWAL, in combination with "cream" or "lotion," would describe a type of exfoliating skin product and that "alpha hydroxy acid" is a common ingredient in an exfoliating cream or lotion. However, considering the mark as a whole, we find that the combination of HYDROXY and RENEWAL in the mark herein is somewhat incongruous such that the meaning of the phrase is not immediately apparent.⁸

We recognize that prospective purchasers are likely to ultimately conclude, upon viewing the mark in connection with the identified goods, that the product is a renewal cream containing alpha hydroxy acids. However, we believe that some thought process is required to draw that conclusion and, therefore, while the mark may be highly suggestive in connection with the identified goods, it is not merely descriptive thereof. Further, we recognize that we must resolve whatever doubt we may have regarding the merely descriptive character of the mark in favor of applicant and the mark should be published for opposition. See, *In re Rank Organization Ltd.*, 222 USPQ 324, 326 (TTAB 1984) and cases cited therein.

⁸ We note that these applications are based on a bona fide intention to use the mark in commerce and, thus, no specimens are of record. If, at such time as specimens are submitted, the mark on those specimens appears to be HYDROXY RENEWAL CREAM, then the issues both of the mere descriptiveness of the mark and whether such use is a material alteration of the mark as originally applied for may bear consideration.

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Decision: The refusal under Section 2(e)(1) of the Act is reversed in each case.

G. D. Hohein

P. T. Hairston

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board